

REMARKS

Status of the claims

With entry of the current amendment, claims 1-20 and 27-29 have been cancelled. Accordingly, claims 21-26 are pending in the application.

The amendments add no new matter.

The amendments to the specification update the priority information, below, and add federal funding support.

Claims 22-26 have been amended to provide proper dependency.

The objection/rejections will be addressed in the order presented in the May 18, 2004 Office Action.

Priority information

The first paragraph of the specification has been updated as required and also revised to indicate that the instant application is a continuation application, not a divisional application.

Oath/Declaration

The Examiner has required a new oath or declaration because the Declaration on file incorrectly designates 08/732,676 as a provisional application. A substitute Declaration is submitted herewith. It designates Application U.S. Ser. No. 08/732,676 as a non-provisional Application.

One of the inventors, Karen Klein, has not signed the substitute Declaration. Therefore, a petition under 37 C.F.R. § 1.47(a) including proof of the pertinent facts, the fee set forth in § 1.17(h) and the last known address of the non-signing inventor accompanies this response.

Obviousness-type double patenting

Claims 21-26 were rejected for alleged obviousness-type double patenting over claim 6 of U.S. Patent No. 6,107,540.

Claims 21-26 were also rejected for alleged obviousness-type double patenting over claims 12-14 of U.S. Patent No. 6,365,797.

Claims 21-26 were provisionally rejected for alleged obviousness-type double patenting over claims 21-26, 29, 31, 32, and 34 of co-pending Application No. 10/022,115.

U.S. Patent No. 6,107,540, U.S. Patent No. 6,365,797 B1, and Application No. 10/022,115 and the subject application are commonly owned by the Regents of the University of California. Applicants submit terminal disclaimers and Certificate under 37 C.F.R. § 3.73(b) with this Amendment. The terminal disclaimers disclaims the terminal portion of the term of a patent granted on the instant application over U.S. Patent No. 6,107,540, U.S. Patent No. 6,365,797, and patents that may grant with the relevant claims of Application No. 10/022,115. Applicants note that the filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. See, MPEP §804.02.

In view of the filing of the terminal disclaimers, Applicants respectfully request withdrawal of the obviousness-type double patenting rejections.

Rejections under 35 U.S.C. § 112, second paragraph

Claim 21 was rejected as allegedly confusing with regard to: the term "issue"; the phrase "a cell suspension thereof" in part (a) of the claim; the reference to "*in vivo*" in part (b); the use of the term "the xenograft" in part (c); and the term "a site distant from the xenograft." In order to expedite prosecution, the claims have been amended. To the extent that the rejection applies to the amended claims, Applicants respectfully traverse.

With regard to "issue", claim 21 has been corrected to read "tissue", thereby obviating this aspect of the rejection.

With regard to the alleged lack of clarity relating to the term "or a cell suspension thereof", the claim recites a xenograft of locally advanced or metastatic prostate cancer tissue, or a cell suspension thereof. Logically, the cell suspension "thereof" refers to the prostate cancer tissue. It is evident that the prostate cancer tissue can be locally advanced prostate cancer tissue or metastatic prostate cancer tissue. Accordingly, with regard to the cell suspension, it can be a cell suspension of either locally advanced prostate cancer tissue or of metastatic prostate cancer tissue. Applicants believe that this is clear from the structure of the claim. Applicants therefore respectfully request withdrawal of the rejection.

With regard to the term "*in vivo*", Applicants believe that the claim is clear. Cells of the xenograft are transduced with the gene *in vivo* in the animal. The gene is introduced *in vivo*, the cells (of the xenograft) are *in vivo*. The transduction is *in vivo*. Applicants therefore respectfully request withdrawal of the rejection.

With regard to the xenograft in part (c), Applicants believe that the amendment addresses the Examiner's concern. Applicants therefore respectfully request withdrawal of the rejection.

With regard to the allegation that "distant" is unclear, although Applicants disagree with the Examiner, claim 21 has been amended to recite a metastatic site distant from the xenograft. Applicants believe that this provides additional context for the meaning of "distant". Applicants therefore respectfully request withdrawal of the rejection.

CONCLUSION

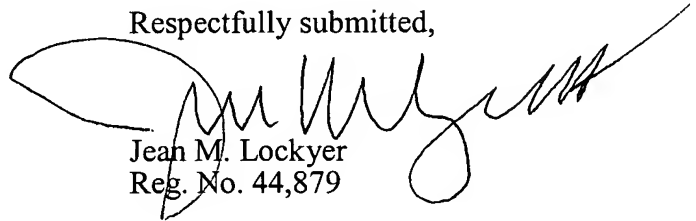
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 10/066,266
Amdt. dated October 18, 2004
Reply to Office Action of May 18, 2004

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jean M. Lockyer', is written over the typed name and registration number.

Jean M. Lockyer
Reg. No. 44,879

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
JML:jml
60335620 v1